



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-18 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

Notice to comply with
Sequence Disclosure
Requirements

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

BEST AVAILABLE COPY

SERIAL NUMBER 08/946710

Art Unit 1761

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless -
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

2. Claims 1-4, 6 are rejected under 35 U.S.C. § 102 (b) as being anticipated by Cummins, Jr. (U.S. Patent 5019382).

See col. 4, lines 19-36, col. 5, lines 50-55, col. 6, lines 12-26, col. 13, and the claims. Such disclosure meets the claims.

3. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4. Claims 5 is rejected under 35 U.S.C. 103 as being unpatentable over Cummins, Jr. (U.S. Patent 5019382). The disclosure is the same as above as discussed for claims 1

and 8. The patent does not disclose an alternate day dosing. However, it does show that a daily dosage is possible, as a single dosage or as divided and administered in a multiple daily dose regimen. The reference also teaches a staggered regimen of 1-3 days per week or month as an alternative to daily dosing. See col. 5, lines 50-55. With such a flexibility as taught by the reference, and since it is common knowledge in the art to employ such a regimen instead of continuous dosing, for a variety of reasons such as, toxicity, the condition of the patient, patient reaction and amelioration of the disease condition, etc., it would have been obvious to one of ordinary skill in the art to adopt an alternate day dosing and administer IFN as shown by Cummins for MS.

5. Claims 1-18 are rejected under 35 U.S.C. 103 as being unpatentable over Cummins, Jr. (U.S. Patent 5019382) in view of Shibutani et al. (Iyakuhi Kenkyu, vol. 18(4), pp. 571-82, 1987) and further in view of Sobel (abstract of WO 9420122 or US Patent 5624895).

The disclosure for the patent is as discussed above. The whole range of dosages claimed by the instant invention is not shown. However, the Shibutani abstract indicates that IFN toxicity studies with rats showed that it was tolerated well. Therefore it would have been obvious to one of ordinary skill in the art to administer dosages higher than that shown in the patent with the reasonable expectation that such doses would not produce toxicity side-effects in humans. It would also have been obvious to

employ such an alternate day dose regimen instead of continuous dosing, for a variety of reasons such as, toxicity, the condition of the patient, patient reaction and amelioration of the disease condition, etc. Note that although Cummins discloses interferon for autoimmune diseases which includes the diabetes claimed herein, the reference does not expressly state that the disease condition is diabetes. However Sobel shows the use of interferon for diabetes. See col. 8, line 63 to col. 9, line 5 and claims 11-12 and 18.

6. Applicant is reminded of the requirements of 37 CFR 1.56 and his duty to submit references in the specification at pages 87-88 for proper consideration and complete examination of this invention, particularly since these references were inaccessible to the examiner.

7. At line 1 of the specification, applicant states that this application is a continuation-in-part of an application filed April 21, 1997, Serial Number not assigned. The examiner could not locate this serial number based on the filing date and as such applicant is requested to furnish this information to the office in response to this action.

8. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

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a. It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

b. Also, even though the specification indicates that the applicant intends to claim C-I-P priority up to application Serial No. 08/226631, there is no reference to the prior applications in the declaration. The declaration must contain a reference to such applications from which priority is being claimed.

c. It does not identify the post office address of each inventor. A post office address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The post office address should be complete and include the ZIP Code designation.

d. The first paragraph of the declaration states that the applicant is the original, first and "co-inventor" of this invention, when in fact there is only one inventor. Clarification is required.

Any inquiry concerning this communication should be directed to Examiner C. Sayala at telephone number (703) 308-3035. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0166. The group fax number is (703) 305-3599.


C. Sayala
Primary Examiner
Group 1700.

Application No.: 08/946710

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other: _____

Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

For PatentIn software help, call (703) 308-6856

PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR RESPONSE

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Art Unit 1761 *

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). (SEE EXAMPLE 31). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicant is given ONE MONTH, or THIRTY DAYS, whichever is longer, from the date of this letter within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for response beyond the SIX MONTH statutory period. Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

CHHAYA D. SAYALA
PRIMARY EXAMINER
GROUP 111

CS 3/25/98